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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/053,788 | 01/18/2002 | Motoi Sato | 13700-269115 | 4278 |
| 23370 | 7590 | 11/02/2007 | EXAMINER | |
| JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309 | | | DURAN, ARTHUR D | |
| | | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/053,788 | Applicant(s) SATO ET AL. | |
| | Examiner Arthur Duran | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-18 have been examined.

Response to Amendment

2. The Remarks filed on 9/20/07 are sufficient to overcome the prior rejection. A new reference has been added to the 35 USC 103 rejection.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/20/07 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greening (2001/0013009) in view of McCarthy (20050288954).

Claims 1, 9, 17, 18: Greening discloses a recommended item presentation method, comprising the steps of:

(a) obtaining client identifier associated client preference estimating factor information of a plurality of clients which is information according to which a preference of each client is to be estimated; and

(b) receiving a recommended item presentation request and a client preference estimating factor information of one client from an item provider server for providing items to a plurality of clients through a network, where the client preference estimating factor information indicates a preference of the one client, [], producing a recommended item list according to the client identifier associated client preference estimating factor information and the client preference estimating factor information, and transmitting the recommended item list to the item provider server (Abstract; Figures 1, 2, 4, 6, 7, 11).

Additionally, note that Applicant's own Specification states that many of the features of the Applicant's claims are obvious; old and well known (Sato, Figures 14 and 15; Paragraphs [1-25]). Also, in the Applicant's Remarks dated 9/20/2007 on page 11, Applicant states that Greening discloses, "Greening discloses a system that predicts the interest of a user in specific items, by directly using information which identifies each client and is directly obtained from each client, similar to (1) described above."

Greening does not explicitly disclose without identifying the one client or that the recommended item list suitable for the one client is provided to the item provider server without requiring any information for identifying the one client from the item provider server.

However, McCarthy discloses recommendations for both non-anonymous and anonymous users and McCarthy discloses without identifying the one client or that the recommended item list suitable for the one client is provided without requiring any information for identifying the one client from the server ([207]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that McCarthy's anonymous users can receive recommendations that are mapped to the preferences of the known users in Greening. One would have been motivated to do this in order to better make recommendations to known and unknown users.

Claim 2, 10: The combination of the prior art discloses the above. Greening further discloses that the step (a) obtains the client identifier associated client preference estimating factor information by receiving a client preference estimating factor information list from a client preference estimating factor information list providing server which collects the client identifier associated client preference estimating factor information from a plurality of clients (Abstract, [15]).

Claims 3, 11: The combination of the prior art discloses the above. Greening further discloses that the step (a) receives the client identifier associated client preference estimating factor information list in a form of a list of item identifiers of viewed/purchased items at the item provider server and dates and times of viewings/purchases of the viewed/purchased items for each client identifier, or a list of item identifiers of viewed/purchased items at the item provider server and ratings indicating levels of interest of each client with respect to the viewed/purchased items for each client identifier, or a list of item

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identifiers of interested items of each client for each client identifier (Abstract, [15]).

Claim 4, 5, 12, 13: The combination of the prior art discloses the above. Greening does not explicitly disclose the step of paying a fee for transmission of the client identifier associated client preference estimating factor information list to the client preference estimating factor information list providing server.

Greening does not explicitly disclose the step of receiving a fee for transmission of the recommended item list from the item provider server.

However, Sato (Applicant's Own Specification) states that it is obvious, old and well known that fees can be charged for advertising, recommendations, or other provided services (Sato, [22]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was that a fee can be charged for providing relevant information. One would have been motivated to do this in order to better provide a source of revenue.

Claims 6, 14: The combination of the prior art discloses the above. Greening further discloses that the step (a) also processes the client identifier associated client preference estimating factor information into a client preference estimating factor information map and the step (b) produces the recommended item list according to the client preference estimating factor information map and the client preference estimating factor information (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 7, 15: The combination of the prior art discloses the above. Greening further discloses that the step (a) produces the client preference estimating factor information map in a form of any of a list of item identifiers of accessed items of each client for each

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client identifier, a list of item identifiers of accessed items of each client and ratings indicating levels of interest of each client with respect to the accessed items for each client identifier, a list of client identifiers of accessing clients of each item for each item identifier, a list of client identifiers of accessing clients of each item and ratings indicating levels of interest of each client with respect to each item for each item identifier, and a list of correlation values among correlated items (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 8, 16: The combination of the prior art discloses the above. Greening further discloses that the step (b) produces the recommended item list by: obtaining a related client list by extracting client identifiers contained in a list of client identifiers for each item that constitutes the client preference estimating factor information map, for each item identifier in a list of item identifiers that constitutes the client preference estimating factor information received along with the recommended item presentation request from the item provider server; narrowing down the related client list by extracting item identifiers contained in a list of item identifiers for each client that constitutes the client preference estimating factor information map, for each client identifier in, the related client list, counting a number of overlaps between extracted item identifiers and item identifiers in the list of item identifiers that constitutes the client preference estimating factor information, for each client identifier in the related client list, rearranging client identifiers in the related client list in a descending order of counted number of overlaps, and setting a first

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prescribed number of client identifiers from a top of a rearranged related client list as a new related client list; obtaining a related item list by extracting item identifiers contained in the list of item identifiers for each client, for each client identifier in the new related client list; and narrowing down the related item list by extracting client identifiers contained in the list of client identifiers for each item, for each item identifier in the related item list, counting a number of overlaps between extracted client identifiers and client identifiers in the new related client list, for each item identifier in the related item list, rearranging item identifiers in the related item list in a descending order of counted number of overlaps, and setting a second prescribed number of item identifiers from a top of a rearranged related item list as the recommended item list (Greening, Figures 1, 4-11; [18, 42, 43, 45, 68, 69]).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in grounds of the rejection above. Please see the rejection of the independent claims above.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are

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given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Jacobi discloses recommendations to a new, unknown shopper; Engberg discloses recommendations to an anonymous user ([29, 194]); as does Linden ([199]); as does Goldstein ([55, 57], claims 6, 7);

a) Bieganski (6,321,221), Lokuge (5,907,836), Sumita (5,907,836) disclose recommendation inventions with relevant features;

b) Dedrick (5,724,521) and Goldhaber (5,794,210) disclose charging for information providing and protecting user privacy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran
Primary Examiner
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10/15/2007